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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS M. COLLINS, KEVIN L. RABINOVITCH,
NEIL A. WILLCOCKS, MARK J. CHIMEL, HENRY V. IZZO,
and ROBERT W. TUTTRUP

Appeal 2010-000728
Application 09/855,584
Technology Center 2400

Decided: June 17, 2010

Before JAY P. LUCAS, STEPHEN C. SIU, and DEBRA K. STEPHENS,
Administrative Patent Judges.

SIU, *Administrative Patent Judge.*

DECISION ON APPEAL
STATEMENT OF THE CASE

This is a decision on appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 6, 17, 23, 29, and 40-71. Claims 1-5, 7-16, 18-22, 24-28, and 30-39 have been cancelled. We have jurisdiction under 35 U.S.C. § 6(b). An oral hearing was held on June 8, 2010.

The Invention

The disclosed invention relates generally to the distribution of e-mail messages to intended recipients (Spec. 1).

Independent claim 6 is illustrative:

6. An article comprising a machine-readable medium storing machine-readable instructions that, when executed by the machine, cause the machine to perform the following operations:
 - enable a sender to input a message;
 - enable the sender to append an attachment to the message;
 - enable the sender to designate at least one recipient of a plurality of recipients to receive the message and the attachment;
 - enable the sender to designate at least one recipient of the plurality of recipients to receive the message without the attachment;
 - enable a recipient to create and edit a reception profile, the profile including the recipient's preferences with regard to receipt of prospective attachments; and
 - transmit the message over a network from the sender to the plurality of recipients, wherein the message is transmitted from the sender without the attachment to any recipient whose reception profile specifies not to receive an attachment, regardless of whether the sender designated the recipient to receive the message with or without the attachment, and
 - wherein if the sender designated the recipient to receive the message with the attachment, the message is transmitted from the sender with the attachment to any recipient whose reception profile specifies to receive an attachment.

The References

The Examiner relies upon the following references as evidence in support of the rejections:

Beck	US 5,903,723	May 11, 1999
Ulrich	US 6,052,735	Apr. 18, 2000
Redpath	US 6,256,672 B2	Jul. 03, 2001 (filed Nov. 12, 1998)
Foladare	US 6,311,210 B1	Oct. 30, 2001 (filed Dec. 17, 1998)

The Rejections

1. The Examiner rejects claims 6, 17, 23, 29, 40-42, 44-46, 48-50, 52-55, 57-60, 62-65, and 67-70 under 35 U.S.C. § 103(a) as being unpatentable over Foladare, Redpath, and Beck.
2. The Examiner rejects claims 43, 47, 51, 56, 61, 66, and 71 under 35 U.S.C. § 103(a) as being unpatentable over Foladare, Redpath, Beck, and Ulrich.

ISSUE 1

Appellants assert that “[t]he cited references do not disclose or suggest any control mechanism that provides for the recipient-side to affect processes at the sender-side, such as whether an e-mail should be loaded onto a network at the sender-side with, or without, an attachment” (App. Br. 7).

Did the Examiner err in finding that the combination of Foladare, Redpath, and Beck discloses or suggests sending a message “from the sender

without the attachment to any recipient whose reception profile specifies not to receive an attachment”?

ISSUE 2

Appellants assert that “Ulrich does not disclose assigning specific time frames” (App. Br. 14).

Did the Examiner err in finding that the combination of Foladare, Redpath, Beck, and Ulrich discloses or suggests a profile that specifies the recipient is not to receive attachments during a particular time frame?

FINDINGS OF FACT

The following Findings of Facts (FF) are shown by a preponderance of the evidence.

1. Foladare discloses “a sending party wishes to send an electronic mail message to a receiving party” (col. 3, ll. 5-6), the message containing “fields of information pertaining . . . to . . . attachments” (col. 3, ll. 10-14).
2. Foladare discloses that a “centralized electronic mail device . . . retrieves information from the profile database . . . [which includes] the amount of electronic mail message data that the electronic mail receiving device . . . is able to receive and display and the portions [of the e-mail] . . . that are to be sent to the electronic mail receiving device” (col. 3, ll. 20-35).

3. Foladare discloses that the “centralize electronic mail device . . . [includes] a determination of whether or not to send attachments, which types of attachments to send, and the like” (col. 6, ll. 33-38).
4. Ulrich discloses indicators that “indicate whether the attachment is scheduled to be downloaded at the next synchronization” (col. 13, ll. 15-16) and an example in which “an attachment has not been chosen to be downloaded, but where the user of mobile device 3 wishes to have the attachment downloaded during the next synchronization” (col. 13, ll. 31-34).

PRINCIPLES OF LAW

35 U.S.C. § 103

The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966).

“The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 416 (2007).

ANALYSIS

Issue 1

Based on Appellants' arguments in the Appeal Brief, we will decide the appeal of the rejection of claims 6, 17, 23, 29, 40-42, 44-46, 48-50, 52-55, 57-60, 62-65, and 67-70 with respect to issue 1 on the basis of claim 6 alone. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Claim 6 recites that a message is transmitted from the sender without the attachment to any recipient whose reception profile specifies not to receive an attachment (App. Br. 16, Claim Appendix). Under a broad but reasonable interpretation of the claim language, claim 6 requires that the message (which may be intended to include an attachment) is transmitted from a sender to a recipient such that the message is ultimately received by the recipient "without the attachment" (i.e., the message is transmitted "to any recipient" "without the attachment").

As described above, Foladare discloses a sender device that sends a message that is ultimately received at a receiving device without an attachment if data from a profile indicates that the particular recipient is not to receive attachments (FF 1-3). We agree with the Examiner that Foladare discloses a sender sending a message to a recipient and the recipient receiving the message without the attachment as recited in claim 6.

Appellants argue that the "the user device 100 [of Foladare] is part of the sender-side and it is distinct from the centralized electronic mail device 160 which receives the e-mail along with any attachments as an 'input.' . . . [T]he centralized electronic mail device 160 and the electronic mail

receiving devices 120-150 are part of the recipient-side” (App. Br. 8). Hence, Appellants argue that the “centralized electronic mail device 160” of Foladare is equivalent to at least a part of the claimed “recipient” while the “user device” of Foladare is equivalent to the claimed “sender” and that Foladare’s centralized electronic mail device (as a “recipient”), and not the “user device” (as the sender), determines whether to send the attachment.

Even assuming Appellants’ contention that Foladare’s centralized electronic mail device 160 and “user device” are equivalent to the claimed “recipient” and sender, respectively, we find that claim 6 does not require that the “sender” determine whether to send the attachment as Appellants contend. As described above, claim 6, when construed broadly but reasonably, merely requires that a message be “transmitted from the sender,” the message being transmitted “to any recipient” and received by the recipient “without the attachment.” Since this appears to be precisely how the Foladare system operates, we cannot agree with Appellants’ argument.

For at least the aforementioned reasons, we affirm the Examiner’s rejection of claim 6, and claims 17, 23, 29, 40-42, 44-46, 48-50, 52-55, 57-60, 62-65, and 67-70, which fall therewith, with respect to issue 1.

Issue 2

Based on Appellants’ arguments in the Appeal Brief, we will decide the appeal of the rejection of claims 43, 47, 51, 56, 61, 66, and 71 with respect to issue 2 on the basis of claim 43 alone. *See* 37 C.F.R. § 41.37(c)(1)(vii).

As described above, Ulrich discloses a user indicating that an attachment not be received until a subsequent synchronization event (FF 4). Since the period of time between the present time and the subsequent event constitutes a “time period” (i.e., a certain length of time), we agree with the Examiner that Ulrich discloses specifying not to receive attachments during a particular time frame (e.g., the time between the present time and when the next synchronization event occurs).

Appellants argue that Ulrich “does not disclose assigning specific time frames” during which time a device may not receive attachments (App. Br. 14) but fail to provide an explanation as to how Ulrich’s disclosure of a specific time frame (i.e., the time period starting at the present time and ending at the next synchronization) differs from the claimed “particular time frame.”

For at least the aforementioned reasons, we affirm the Examiner’s rejection of claim 43, and claims 47, 51, 56, 61, 66, and 71, which fall therewith, with respect to issue 2.

CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that the Examiner did not err in:

1. finding that the combination of Foladare, Redpath, and Beck discloses or suggests sending a message “from the sender without the attachment to any recipient whose reception profile specifies not to receive an attachment” (issue 1); and

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2. finding that the combination of Foladare, Redpath, Beck, and Ulrich discloses or suggests a profile that specifies the recipient is not to receive attachments during a particular time frame (issue 2).

DECISION

We affirm the Examiner's decision rejecting claims 6, 17, 23, 29, and 40-71 under 35 U.S.C. § 103.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

msc

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